

REMARKS

The present application was filed March 29, 2001, with claims 1-21, as a continuation of application Serial No. 08/977,382, filed November 24, 1997, now U.S. Patent No. 6,573,927, which claims priority to provisional application Serial No. 60/037,963, filed February 20, 1997.

Claims 1, 2, 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,861,918 (hereinafter "Anderson") and U.S. Patent No. 6,243,171 (hereinafter "Haneda").

Claims 3-7, 10, 11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson and Haneda in further view of U.S. Patent No. 6,344,875 (hereinafter "Hashimoto").

Claims 8, 9, 12, 13, 20 and 21 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In this response, Applicants traverse the §103(a) rejections, amend independent claims 1 and 14, rewrite claims 8, 12 and 20 in independent form, and add new dependent claims 22 and 23. Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

Applicants initially traverse the §103(a) rejection on the ground that the Anderson and Haneda references, even if assumed to be combinable, fail to teach or suggest all the limitations of at least independent claims 1 and 14, and on the further ground that insufficient motivation has been identified for the proposed combination.

In formulating the §103(a) rejection, the Examiner acknowledges that Anderson fails to teach or suggest the claimed utilization file identifying one or more digital image files to be transferred to a service provider, but argues that Haneda supplies the missing teachings. Applicants respectfully disagree. The Haneda reference is directed to "a laboratory system installed at a processing laboratory . . . , such as a film developing establishment (store) or photography shop, which develops film and prints on photographic paper or makes extra prints" (Haneda, column 13, lines 58-63). Applicants note that the laboratory system of Haneda FIG. 1 requires a film reader 12 which "reads images of frames appearing on the developed film" (Haneda, column 14,

lines 33-34). Thus, Haneda teaches that a user must deliver film to a processing laboratory in order to have that film scanned and converted to digital image files. This is contrary to the claimed arrangements, in which digital image files, generated by digitizing captured image signals, are transferred to a service provider. Accordingly, it is believed that the proposed combination of Anderson and Haneda fails to meet the claim limitations.

Furthermore, by teaching an arrangement which requires that digital image files be generated not by digitizing captured image signals, but instead using a film reader in a processing laboratory, Haneda teaches away from the proposed combination with Anderson. Accordingly, one skilled in the art would not be motivated to make the proposed combination.

The Hashimoto reference fails to supplement the fundamental deficiencies of the proposed combination of Anderson and Haneda.

Notwithstanding the foregoing traversal, Applicants have amended independent claims 1 and 14 to clarify the subject matter which Applicants regard as the invention. More specifically, these claims have been amended to specify that the utilization file comprises account information utilizable by the service provider in processing the one or more digital image files identified in the utilization file. Support for the amendment can be found in the specification at, for example, page 6, lines 21-22, and in FIG. 4.

Claims 1 and 14 have also been amended to refer more generally to a memory, rather than to an internal memory or a removable memory card. The memory recited in claims 1 and 14 may comprise, by way of example, an internal memory of an electronic still camera, a removable memory card of an electronic still camera, or a combination of both an internal memory and a removable memory card. New dependent claims 22 and 23 are explicitly directed to such exemplary arrangements. Support for this amendment to claims 1 and 14, and for new claims 22 and 23, can be found in the specification at, for example, page 4, lines 8-22.

In view of the traversal above, it is respectfully submitted that the amendments to claims 1 and 14 are made not for reasons of patentability relative to the

cited references, but are instead made solely in order to expedite prosecution of the application.

It is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

A duplicate copy of this communication is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Pamela R. Crocker", is written over a horizontal line.

Pamela R. Crocker
Attorney for Applicant(s)
Registration No. 42,447

PRC:cjm
Telephone: (585) 477-0553
Facsimile: (585) 477-4646